

B1 17. (New) A box as set forth in claim 16 further comprising:
a spacer integrally connected to each of the inner side walls and disposed between each of the pair of inner side walls and each of the corresponding outer side walls.

REMARKS

In response to the Office Action mailed on April 9, 2003, Applicant respectfully requests reconsideration in view of the foregoing amendments and the following remarks. By this amendment, claims 1, 3-4, and 6 have been canceled. Also by this amendment, claims 2, and 7-11 have been amended. New claims 12-17 have been added. Claims 2, 5, 7-17 are pending for examination with claims 2 and 12 being independent claims. No new matter has been added by this amendment.

Drawings

In the Office Action, the Examiner objected to the drawings for not showing the front or back wall shaped or sized to be positioned at least in part engaging the cable on the spool, as recited in claim 7. Claim 7 has been amended to recite a panel shaped and sized to be moved from a position in a plane common with an outer wall to a position at least in part engaging the cable on the spool. By this response, a proposed correction to Figure 10, showing an embodiment of the above-recited feature is submitted. The Examiner's approval is respectfully requested for the proposed changes to Figure 10, highlighted in red in the attached copy.

Claim Rejections – 35 U.S.C. §103

Claims 1-11, including independent claims 1 and 2, were rejected under 35 U.S.C. §103(a) as being obvious over Barnett et al. (U.S. Patent No. 5,704,479) in view of Gaffney (U.S. Patent No. 4,382,510). Applicant has canceled claim 1. Applicant has amended claim 2 to further define over the applied prior art.

Independent Claim 1

By this amendment, independent claim 1 has been canceled without prejudice.

Independent Claim 2

Claim 2 has been amended to incorporate features of cancelled claim 4, among other features. Independent claim 2 is directed to a box for dispensing cable comprising, *inter alia*, at least six outer walls forming an exterior of the box, the at least six outer walls formed of a single sheet of cardboard. A panel formed in one of the walls of the box, the panel adapted to be displaced to provide an opening. A cable spool support is located in the box and includes journals to rotatably support a spindle of a spool cable for dispensing cable through the opening from the spool in the box. The cable spool support comprises a pair of rigid supports integrally formed of the single sheet of cardboard and positioned opposite one another. Each of the pair of rigid supports closely fit at least portions of five of the at least six walls, including a top and bottom wall of the box.

In the Office Action, the Examiner recognized that Barnett fails to disclose the box and each of the pair of supports formed from a single sheet of cardboards in his rejection of dependent claim 4, the features of which are now included in independent claim 2. However, the Examiner concluded that it would have been obvious to one skilled in the art to form the box and the supports from a single sheet of cardboard. The Examiner alleged that it would have been an obvious matter to form in one piece an article which has formerly been formed in two pieces. Applicant respectfully disagrees and submits that the Examiner has failed to establish a *prima facie* case of obviousness.

In rejecting claim 4, the features of which have now been incorporated into independent claim 2, the Examiner asserted that forming in one piece that which has formerly been formed in two pieces is obvious, citing Howard v. Detroit Stove Works, 150 U.S. 164 (1893). Applicant respectfully disagrees.

This rejection is legally unsupportable as it relies on a purported *per se* rule of patentability. The Federal Circuit has held that such *per se* rules have no force. See, e.g., In re Ochiai, 37 USPQ 2d 1127, 1133 (Fed. Cir. 1995) (“the use of *per se* rules ... flouts section 103 and the fundamental case lay applying it.”). Consequently, to support a rejection, an examiner must specifically identify from the prior art from the motivation to make the claimed invention. There is no shortage of federal circuit cases reversing rejections for failure to do so. See, e.g., In

re Dembiczak, 175 F.3d 994, 50 USPQ 2d 1614 (Fed. Cir. 1999) (reversing rejection because motivation in the prior art not identified).

Once the Howard *per se* rule is removed as legal error, nothing is left to support the rejection of claim 2 as amended to include features of claim 4. The record is devoid of any teaching or suggestion that would have led one of ordinary skill in the art at the time of the filing the application to modify the Barnett box to have supports formed from the same sheet of cardboard as the box itself is formed. Thus, the prior art of record fails to provide a motivation to modify the Barnett box to include supports integrally formed from the same sheet of cardboard.

In view of the foregoing, it is respectfully asserted that the Examiner has failed to establish a *prima facie* case of obviousness, such that the rejection of claim 2, which has been amended to incorporate features of claim 4, under §103(a) as being obvious over Barnett is improper and should be withdrawn.

Claims 7-11 depend from independent claim 2 and are patentable for at least the same reason.

Applicant further submits that the construction of the box, as recited by amended independent claim 2 is far superior to those constructions of either Barnett or Gaffney as it 1) possesses superior strength and 2) can be made at a lower cost. Contact between the supports and at least five of the six walls that form the exterior of the box provide additional supporting structure that is not found in either Barnett or Gaffney. Such a feature is not shown by either Gaffney or Barnett.

Furthermore, the box as claimed by the applicant in independent claim 2 is made from a single sheet of cardboard. Manufacturing an entire box from a single sheet can reduce the amount of material required to make a single box and also reduce the number of assembly steps required for constructing a box. Furthermore, the number of box parts that must be kept in inventory can be reduced, as each box is made of a single sheet of cardboard and can be stored easier than boxes requiring multiple components. The reduction of material required, the reduction of the number of assembly steps required, and the reduction of required storage space

allow the box, as recited in independent claim 2, to be manufactured and stored at a lower cost than those of Barnett or Gaffney.

New Claims

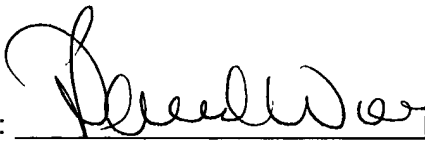
Applicant has added new independent claim 12 and claims 13-17 which depend therefrom. Independent claim 12 is directed to a box for dispensing cable from a spool. The box comprises, *inter alia*, an inner side wall that defines a journal for supporting the spool. The box also comprises an outer side wall forming an exterior portion of the box and being adjacent and parallel to the inner side wall, where the inner side wall and the outer side wall are integrally formed from a common sheet of cardboard. Applicant respectfully submits that independent claim 12 is in allowable condition at least because none of the prior art of record discloses such features. Claims 13-17 depend from claim 12 and are believed to be patentable for at least the same reason.

CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,
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MARKED-UP CLAIMS

2. (Amended) A box for dispensing cable, the box comprising:
[a pair of opposed, rectangular side walls;
a front wall adjacent to each of the pair of side walls;
a back wall adjacent to each of the pair of side walls and opposite from the front wall;
a top wall adjacent to each of the pair of side walls, the front wall and the back wall;
bottom wall adjacent to each of the pair of side walls and opposite the top wall;]
at least six outer walls forming an exterior of the box, the at least six outer walls formed
of a single sheet of cardboard;
a panel in one of the walls [a wall] of the box, the panel adapted to be displaced to
provide an opening [in the wall]; and
a cable spool support located in the box, the support including journals to rotatably
support a spindle of a spool of cable for dispensing cable through the opening from the spool in
the box, wherein the cable spool support comprises a pair of rigid supports integrally formed of
the single sheet of cardboard and positioned [adjacent] opposite one another [walls] and each
closely fitting at least portions of five [walls] of the at least six walls including a top and a
bottom wall of the box, each of said supports including [a] the journal integrally formed in the
support and shaped to receive an end of [a] the spindle supporting [a] the spool of [wire] cable],
said spool of wire including a spindle, with the spool positioned between the supports one from
the other, the end of the wire on the spools removable from the box through said opening].

7. (Amended) A box as set forth in claim [5] 2, wherein [having a] the panel [in one of
the front or back walls, said panel] is shaped and sized to be moved from a position in a plane
common with [the front or back] an outer wall to a position at least in part engaging the cable on
the spool.

8. (Amended) A box as set forth in claim 7 wherein [said] the panel has a hinged
connection with an outer wall to enable the panel to [is adapted to] be moved to the position
engaging the cable on the spool, further wherein the panel is adapted to be folded along a line

[intermediate the ends and to be hinged along a parallel] line parallel to the hinged connection
[for movement from and to said plane].

9. (Amended) A box as set forth in claim [3] 2 wherein each of said rigid supports comprise an internal panel integrally connected to [the] an upper edge of one outer wall of the at least six outer walls [a side wall] and folded inwardly against an [the] inner surface of said [side] one outer wall.

10. (Amended) A box as set forth in claim 9 wherein the internal panel is formed with an opening having a lower edge that extends transversely across a portion of the internal panel at a spaced distance from a lower edge of [the side wall] said one outer wall forming a supporting surface for [an] the end of the spindle.

11. (Amended) A box as set forth in claim 10 having spacers integrally connected to the lower edge of the internal support and folded between the internal support and said one outer wall [side wall] to form a reinforcing member for said supporting surface.